

No. 472.

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IN THE  
UNITED STATES CIRCUIT COURT OF APPEALS  
FOR THE  
NINTH CIRCUIT

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Herman Cramer,

*Plaintiff in Error,*

VS

The Singer Manufacturing Co.,

(A Corporation,)

*Defendant in Error.*

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DEFENDANT'S REPLY TO THE REPLY  
BRIEF OF PLAINTIFF.

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CHAS. K. OFFIELD,  
M. A. WHEATON,  
I. M. KALLOCH,

*Attorneys for Defendant in Error.*



In the United States Circuit Court of Appeals,  
for the Ninth Circuit.

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HERMAN CRAMER,

*Plaintiff in Error.*

*vs.*

THE SINGER MANUFACTUR-  
ING COMPANY,

(A CORPORATION),

*Defendant in Error.*

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S. F.  
No. 472.

In this Court of Appeals the documents filed in this case are (1) the transcript of record, (2) a brief on behalf of plaintiff in error, (3) a brief on behalf of the defendant in error, and (4) the reply brief of plaintiff in error. At the close of the oral argument leave was given to the plaintiff in error to file such reply brief, and at the same time leave was given to defendant in error to answer the same. This brief is our reply to said reply brief of plaintiff in error.

On pages 1 and 2 of said reply brief the plaintiff in error admits the law of *res adjudicata*, and admits to be a matter of universal and common knowledge.

On page 2 of said reply brief the statement is made that in the former case of *Cramer vs. The Singer Manufacturing Company and Willis B. Fry*, there was no judgment or decision that Cramer's patent was invalid.

This statement is entirely correct. The judgment roll in that case shows such to be the fact. So also does the decision of his Honor, Judge McKenna, reported in 68 Fed. Rep. 201. Upon these matters counsel upon both sides of this controversy agree. On the same page 2 of said reply brief the statement is made that the issue in the said former case of *Cramer vs. The Singer Manufacturing Company and Willis B. Fry* was as to whether Fry had infringed Cramer's patent. This statement is also correct, as the said judgment roll in said case and also the decision of his Honor, Judge McKenna, show. Upon this matter of fact counsel upon both sides agree. Such being the case, all that is said in said reply brief on pages 2, 3 and 4, with regard to the effect of having a patent declared invalid by a court, has no relevancy whatever to this case. No patent was declared invalid in the said case of *Cramer vs. The Singer Manufacturing Com-*

*pany and Willis B. Fry*; neither has any patent been declared invalid in the present case. So far as either of said suits are concerned, the plaintiff's patent stands in the condition of being valid and unimpeached.

In the former case, as stated on page 2 of said reply brief, the issue was whether Fry had infringed Cramer's patent. The judgment of the Court was that he had not infringed.

Beginning near the bottom of page 69 of the transcript there is shown a copy of the judgment entered in that case. A portion of that judgment is as follows:

“ After hearing the evidence and considering  
 “ the motion of defendant's counsel that the jury  
 “ find a verdict for defendant, it was ordered by  
 “ the Court that said motion be granted, and  
 “ thereupon the jury was instructed to return a  
 “ verdict for the defendant *on the ground of non-*  
 “ *infringement* which was done as follows,” etc.

Also in the opening brief of the plaintiff in error, on page 4, the statement is made that the judgment in the Fry case “ upon its face, and in  
 “ express terms stated that it was upon the  
 “ grounds of non-infringement.” Also in our former brief, on page 26, we state the same thing. It is therefore a fixed fact that one ultimate issue decided in the former case of *Cramer vs. Fry* was, that Fry had not infringed the plaintiff's patent.

In the present case we have plead the judgment in the case of *Cramer vs. Fry* as a bar to the prosecution of this suit, alleging that the said action — which action was No. 11,808 — was brought against The Singer Manufacturing Company and Willis B. Fry as the managing agent of said company. That the said action was brought by the plaintiff herein against The Singer Manufacturing Company and said Willis B. Fry upon the identical patent herein sued upon. That in said action, No. 11,808, The Singer Manufacturing Company objected to the action being maintained against itself, upon the ground that it was a non-resident of this district and a resident of another State. That the said objection was sustained by this Court and the said action, No. 11,808 was thereupon dismissed as to The Singer Manufacturing Company, but was thereafter proceeded with against said Fry only. That Fry was then the general manager of the business of this defendant on the Pacific Coast, and that the sole and only acts of infringement which were in said action charged against said Fry consisted in the selling of sewing machines which contained treadles and treadle mechanism constructed according to the claims of the Diehl patent. That upon the trial of said action the plaintiff proved the commission by the defendant Fry of the acts which were charged in the declaration in said action to be infringements of plaintiff's patent, and

proved in that case that The Singer Manufacturing Company had made and sold numbers of sewing machines containing the treadles and treadle mechanism described in the said Diehl patent. That in and during the trial of said action the treadles and treadle mechanism which had been made by The Singer Manufacturing Company, and which had been sold by said Willis B. Fry as the agent of said company, and which, in said action, were charged to infringe plaintiff's patent, were carefully and fully compared with the treadle and treadle mechanism described in the plaintiff's patent and alleged by the plaintiff to have been his invention, and the Circuit Court thereupon, when the taking of testimony in said action was concluded, decided that the making and selling of treadles and treadle mechanism, constructed according to the said Diehl patent, did not constitute any infringement of the plaintiff's patent, and the Circuit Court thereupon ordered judgment to be entered in said action in favor of said Willis B. Fry, and against the said plaintiff, and judgment was accordingly so entered on the 12th day of April, 1895, which judgment is still in full force and effect. These and other matters are more specifically stated in our said answer than they are here stated. The answer further alleges (transcript, p. 44) that The Singer Manufacturing Company "by and through "its attorneys, openly assumed control of the

“defense of said action, No. 11,808, and managed said defense at all stages thereof and throughout the trial of said action, and until the judgment therein became final, and defrayed all the expenses of said defense.” The answer further sets up that the infringements of plaintiff’s patent, which are charged in this case to have been committed by The Singer Manufacturing Company, consist entirely and solely of the making and selling of treadles and treadle mechanism constructed according to said Diehl patent, and that the plaintiff does not in this action charge The Singer Manufacturing Company with having infringed its said patent in any other manner than by making and selling treadles and treadle mechanism constructed according to the Diehl patent.

The answer in this case further avers that as the treadles and treadle mechanism which were made by The Singer Manufacturing Company, and which were sold by it, by and through its agent, Willis B. Fry, were in said action No. 11,808 adjudged not to infringe the plaintiff’s alleged invention and not to infringe the plaintiff’s alleged letters patent herein sued upon, and that the judgment in said action No. 11,808 is a bar to this action, etc.

See transcript, p. 41 to the bottom of page 44.



The Court will notice, therefore, that what we allege *to have been adjudicated* in the former action was that *sewing machine treadles and treadle mechanism made according to the description of said Diehl patent was not any infringement of the Cramer patent herein sued upon.*

The Circuit Court, in the trial of this case, decided and adjudged that our plea was good and that the treadles and treadle mechanism which was shown to have been manufactured and sold by The Singer Manufacturing Company, and which was the only thing that was claimed to be an infringement of the plaintiff's patent, had been adjudged in said former suit No. 11,808 not to infringe said patent, and therefore directed the jury to bring in a verdict for the defendant upon the ground that the same question had been already adjudicated by the Circuit Court in a case to which The Singer Manufacturing Company was an actual, although not a nominal, party.

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### **Judge McKenna's Opinion.**

In the plaintiff's opening brief, beginning near the bottom of page 10, under subdivision II, counsel took the position that the opinion of the Court was not *proof of the facts stated in the opinion*, and cited many cases to sustain that

proposition. In our former brief, commencing at the middle of page 18 and going to the bottom of page 25, we took the position, and we think we showed, that there was no such question involved in this controversy, and cited many cases to show that the opinion of the Court was proper evidence for the purpose of *showing what the Court had decided and adjudicated in the case.*

We contend then, as we contend now, that the question is not what were the *facts proven* before Judge McKenna, but the question that is pertinent to this case is what *facts in issue were decided and adjudicated* by Judge McKenna. We refer to said portions of our former brief for reasons and authorities to sustain our position,

In the said reply brief, which we are now answering, counsel, under the fourth subdivision, page 6, returned to the charge and still insist that the opinion of Judge McKenna was not competent proof of the facts *stated in that opinion.* They thus seem to attempt to convince this Court that it was necessary, in order to show what Judge McKenna had decided the facts to be which were disputed and put in issue by the pleadings, that all the facts in evidence upon which he based his decision must be shown in this case.

We, on the contrary, aver that it is not necessary for us to show facts that were merely intro-

duced in evidence before Judge McKenna, any further than they are required and needed in order to show what issue of fact was adjudicated by Judge McKenna. Facts *in evidence* are one thing, while facts *adjudicated* are another thing.

Counsel seem unable to grasp the difference between these two propositions, viz.: the difference between *what issue of fact Judge McKenna decided and adjudged* and what facts were *given in evidence* upon which the Court based such adjudication.

Plaintiff's counsel insist that it was necessary for us to show the facts upon which Judge McKenna based his adjudication. We, on the contrary, say that that is not necessary, but the only thing required of us is to show what that adjudication was, and we need not show what were the facts given in evidence upon which the adjudication was based. If the plaintiff's counsel are unable to discern the difference between the two propositions, this Court will discern it at a glance.

As an illustration showing this, we will refer to facts stated in the opinion of Judge McKenna, as shown in 68 Fed. Rep., beginning just about the middle of page 207, where the Court says: "That brings us to the second ground of defendant's motion." The Court then went on stating facts which were obtained from the file wrapper con-

tents which begin with showing Cramer's first application for a patent and conclude by showing the granting of the patent upon which the suit is based. Numerous amendments were made by Cramers' attorneys in the Patent Office. Certain things claimed by him were abandoned by the amendments which he made in the Patent Office. These changes and abandonments were shown by the file wrapper contents, and were before Judge McKenna, and it was largely upon these changes and amendments to Cramers' application, made by him in the Patent Office, that Judge McKenna construed the patent and held it to a somewhat narrow construction.

Now, is it not perfectly palpable and almost self-evident that, in ascertaining what facts in issue Judge McKenna decided and adjudicated it is not necessary for us to go back and ascertain the probative facts upon which he based that adjudication? When he adjudged that the plaintiff's patent should receive a construction so narrow that it would not cover the treadles sold by Fry, such adjudication is all of that adjudication that we want, and it is all that this Court wants, and it was all that the Circuit Court required, and it is all of the adjudication that can be used in this case. The other ultimate fact adjudged by Judge McKenna to the effect that Fry would have been an infringer if the Diehl machines had

infringed is not pertinent to this case. Nobody for a moment supposes it was necessary, in order to show what Judge McKenna adjudged, that we should be required to put in evidence the said file wrapper contents, and thus show the evidence upon which the Judge based his judgment.

For the distinction between the necessity of showing the facts in issue and showing the probative facts upon which the adjudication of the facts in issue was based, see

*Sullivan vs. Triunfo M. Co.*, 39 Cal., 459, on first half of page 465; and *Marshall vs. Shafter*, 32 Cal. 176, pages 192 and 193.

The judgment roll in the Fry case was admitted in evidence for the purpose of showing the issues which were adjudicated, and Judge McKenna's opinion, which was a written document filed in the case, was introduced for the purpose of showing just how those issues were decided. For instance, Fry's counsel claimed in that case that he did not infringe because he was only an agent of The Singer Manufacturing Company, and even if the Diehl treadles and treadle mechanism was an infringement of the plaintiff's patent, and although they were sold by The Singer Manufacturing Company, under the supervision of Fry, still Fry did not infringe. Fry also claimed that such treadles and treadle me.

chanism made and sold by the Singer Manufacturing Company was not an infringement of the plaintiff's patent. Now, here were two distinct grounds upon which the adjudication that Fry had not infringed the plaintiff's patent might have been based. The first one of these grounds, viz.: that Fry did not infringe because he was only an agent has no application to the present case, because Fry is not sued in the present case; and the question as to whether or not his relations as agent of The Singer Manufacturing Company would make him liable as an infringer is not involved in the present case at all. The other question, however, as to whether or not the machines which were made and sold by The Singer Manufacturing Company under Fry's supervision was an infringement of the plaintiff's patent is directly in issue in this case. It therefore become necessary for us, in the present case, to show that Judge McKenna had decided and adjudged that the machines which were made and sold by The Singer Manufacturing Company through Fry as its agent were not any infringement of the plaintiff's patent, because that is the very issue involved in the present case. We therefore, in addition to the judgment roll, put in evidence the opinion and decision (for the decision is contained in the closing part of said opinion) for the purpose of showing that the judgment of non-infringement in Fry's favor was based upon

the *adjudged fact* that the machines which The Singer Manufacturing Company made and sold were no infringement of the patent sued upon.

That the said opinion in connection with said judgment roll was competent evidence to prove that this was the very thing adjudged by Judge McKenna is fully sustained by the numerous authorities which we heretofore cited, and the plaintiff's counsel have not cited any authority whatever to contradict or destroy the effect of those which we have cited. Their citation of authorities to show that Judge McKenna's opinion could not be received as "proof of the facts *therein stated*," are not entirely irrelevant and impertinent, since it was necessary for us to prove any of the facts which are stated in Judge McKenna's opinion and upon which he based his adjudication that the Diehl machines did not infringe. On pages 9 and 10 of the plaintiff's said reply brief, in referring to the cases cited in our former brief to show the admissibility of said opinion in evidence, counsel say:

" All that the cases decide is that where evi-  
 " dence is introduced in support of more than  
 " one issue upon which the former trial was had,  
 " and where evidence was introduced equally  
 " applicable to two or more issues, the opinion of  
 " the Court may be examined for the purpose of  
 " showing the question of law which was actually

“ decided, not for the purpose of showing *what*  
 “ *were the facts admitted in evidence.*

Now, this is just exactly the purpose for which the opinion of Judge McKenna was introduced in evidence. It was for the purpose of showing which one of the two issues of fact which we have mentioned was adjudged in Fry's favor. Was he adjudged to be a non-infringer for the reason that he was not liable for the sales of The Singer Manufacturing Company made under his supervision? Or was he adjudged to be a non-infringer because it was first adjudged that the machines made and sold by The Singer Manufacturing Company did not constitute any infringement of the plaintiff's patent? If he was adjudged to be a non-infringer upon the first ground, such judgment would not be of any assistance to us in this case. But if there was an adjudication that the machines made and sold by The Singer Manufacturing Company was not any infringement of the plaintiff's patent and Fry was adjudged to be a non-infringer upon that ground, such judgment makes this point of our defense good in this case. The opinion of Judge McKenna, which includes his decision, is the best evidence to prove what his decision actually was. (See authorities cited by us in our former brief, commencing on page 23 with a reference to Freeman on Judgments, and continuing to the bottom of page 25.)



In using a former decision of the courts, whether it be used as proof of a judgment in bar, or whether it be referred to as an authority, there are two classes of facts to be considered. One of those classes of facts is: What facts has the Court decided? The other class of fact is: Upon what facts does that decision rest? Suppose, for instance, that we cite as an authority a decision of the Supreme Court. We use it for the purpose of ascertaining what the law is which is to be applied to a certain state of facts. Judgments of courts are usually mixed, and contain decisions both of law and of facts. They often consist of the application of the law to a given state of facts, after the Court has decided what the facts are. In referring to a decision of the Supreme Court, in order to understand what is the rule of law, which is there decided, we must ascertain what the facts were to which the law is applied. We look to the opinion of the Court, for the purpose of ascertaining what the facts were upon which the Court based its decision. We never, however, think of looking to the proof in the case to see whether those facts actually existed or not. Whether the facts actually existed or whether they were only assumed to exist by the Court does not make the least difference in ascertaining what is the rule of law that the court is deciding. The facts are taken to be as stated in the opinion of the Court

for the purpose of ascertaining what the Court decided the law to be, because it is to those stated facts that the Court applies the law. If, in another case, the facts are proved to be the same as the facts which are stated in the opinion of the Supreme Court, then the law as applied to such facts by the Supreme Court becomes an authority. But if the facts are proved to be different from the facts which are stated in the decision of the Supreme Court, then that decision is not an authority. When in any case a litigant is striving to bring himself within the protection of a decision by proving the existence or non-existence of any facts upon which the decision was based, it is a matter of course that the statement of facts contained in the opinion of the Court is not competent evidence nor any evidence to prove the actual existence of those facts. We have never assumed or said anything of the kind. The citation of authorities by the plaintiff in error to show that a statement of facts contained in the opinion of a court is not competent proof or any proof of the existence of those facts is lost labor. There is no such question involved in this case. The bringing in of those authorities and the assumption that we had made any assertion that the statement of facts contained in Judge McKenna's opinion should be taken as proof of the existence of those facts in the subsequent case is going

outside of the issues in the present case. It puts us in mind of the old story of a Western doctor, who was called to attend to a case of sickness which he confessed he did not understand. He however assured his patient that although not qualified to treat the disease with which the patient was suffering, he could nevertheless give him medicine that would throw him into fits, and he, the doctor, was death on fits and could cure them every time. The fact which we undertook to prove was what specific issue of fact did Judge McKenna decide and what was his decision upon that issue? We did not undertake to prove what facts he based that decision upon, and this assumption of plaintiff's counsel that we were offering to prove what facts Judge McKenna based his opinion upon seems to be only an effort to get the case into "fits," which could be reached and cured by the irrelevant authorities cited by them.

Our effort was to prove the fact that Judge McKenna had adjudicated that the machines made and sold by The Singer Manufacturing Company were not an infringement of the plaintiffs patent. The judgement roll, which we introduced in the Fry case, proved that the plaintiff in this case was the same as in that; that both suits were brought for an infringement of the same identical patent.

In the present case the plaintiff had introduced the machine, Exhibit G, and claimed that that was the machine that was made and used by The Singer Company and the manufacture and sale of that machine by The Singer Manufacturing Company was the only proof of infringement which the plaintiff had undertaken to make in this case. While the record may not show this, we have a right to state and assume it, because the burden of showing error is upon the plaintiff, and if he had wanted to show in making up his bill of exceptions that there was any evidence of any other infringement by the defendant other than the manufacture of said machine, Exhibit G, such evidence of some other claims of infringement should have been put in the bill of exceptions.

The proof, therefore, of the suit being by the same plaintiff, and on the same patent, being made, and the plaintiff having closed his case by proving that the defendant made and sold machines of which Exhibit G was a sample, it only remained for the defendant to show that Exhibit G was the identical machine which Judge McKenna had decided was not any infringement of the patent sued on. When we asked the witness Fry whether that Exhibit G was not the identical machine which was introduced in evidence in the case against him, we were offering

competent and pertinent evidence going to show what issue in fact Judge Kenna had decided. We were all the while trying to prove as a fact what Judge McKenna had decided. We were not trying to prove what the facts were upon which he based that decision. We wished to prove the fact that he had adjudicated that the machine, Exhibit G, and others exactly like it, was not an infringement of the plaintiff's patent. The question we asked Mr. Fry was therefore pertinent and proper. The Court had already examined the record in the former case and knew what was there decided, and seemed to express the opinion that if we proved that Exhibit G was the only machine claimed to be an infringement in each of the two cases that we would have to go into the whole question of what evidence was offered in the former case. Mr. Miller, still urging his objection, stated that the whole evidence would have to be gone into, and to this the Court said "yes." Mr. Offield, one of defendant's counsel in the case, asserted that the testimony was relevant to show that the question of infringement determined in that question was precisely the same as in this case. The Court, however, stated that its mind was made up that if the record did not show that fact that the defendant might be permitted to show it, but the Court had made up its mind that this was the case that was tried before and said: "I have looked over the old case and think

“ the patents introduced there are the same as  
“ those introduced here. The same evidence is  
“ introduced here that was introduced there. I  
“ could not well determine that without going  
“ over the whole evidence.” Mr. Wheaton then  
stated that notwithstanding the Court had made  
up its mind and really knew that the two cases  
were the same, still he supposed that the defen-  
dant was required to make out a full case so as  
to make up the record and show not only that  
The Singer Manufacturing Company made the  
fight in the Fry case but that the same question  
was litigated and determined by the judgment in  
that case which they are now litigating here.

The Court will notice that the fact which the  
defendant was trying to show was, as we have  
already stated, that the same question was liti-  
gated and determined by the judgment in that  
case which they were litigating in this, and we  
did not undertake to show what facts had been  
proved in the former case. Mr. Wheaton con-  
tinued: “ That is why the machine which was  
“ charged to be an infringement in that case by  
“ the proof, not by the complaint, but by the  
“ proof, is the same identical machine which is  
“ charged to be an infringement here ; that is  
“ this machine made under and in accordance  
“ with the Diehl patent. To show that, I thought  
“ the quickest way and most certain way was to  
“ show that that identical exhibit, not another

“ machine of the same kind, but the same identical exhibit, the standard of the Diehl machine, the standard made under the Diehl patent, was the same identical machine that was introduced as the infringement in that case.” The Court, however, remarked : “ That is going into the evidence,” and repeated that he had looked over the decision given by Judge McKenna and the same patents that the defendant had introduced here already, the Diehl patents and others, were referred to.

Counsel state on page 6 of their said reply brief that our views on the question of the admission in evidence of the said opinion of Judge McKenna are entitled to the dubious method of novelty. This we deny. The opinion was offered in evidence solely for the purpose of showing what issue of fact had been adjudicated in the defendant's favor. This was exactly such a use as had heretofore been made of the opinions of courts when introduced as evidence in subsequent cases. There was therefore no novelty whatever in introducing the opinion in evidence for the purposes for which we did introduce it.

Counsel next say, on the same page, that in our former brief we made the statement that the opinion of Judge McKenna was not submitted nor read to the jury, and this statement, they assert, is astonishing. We see nothing to excite surprise

or astonishment in the statement at all. The opinion was introduced in evidence. A motion was made that the jury be instructed to find a verdict for the defendant. This was taking the case away from the jury, and, the motion being granted, it was not at all necessary or requisite that the opinion should be formally read to the jury. The opinion was in evidence, and the Court acted upon it as a part of the evidence. As the Court had determined to take such action of what possible use would it have been to have submitted or read that opinion to the jury? Although this was a jury trial, it was the Court that decided upon all the evidence in the case, and it was not left for the jury either to consider or decide upon any of the evidence taken in the case. How often is it the fact that written documents are introduced in evidence in a jury trial with the agreement that they will not be formally read to the jury until the oral argument takes place. This very frequently occurs. In all such cases, whenever the Court directs a jury to find a verdict, either for or against the plaintiff, such written documents are not submitted to the jury at all and are not read to the jury at all. Counsel say: "We have always supposed that in the trial of an action at law, all the evidence had to be submitted to the jury, and that the jurors are the triers of the facts in the case." If this statement of counsel is literally true, it must be that they have yet to



learn that there have been in the past, and will be in the future, many jury cases in which the Court will properly direct what verdict shall be rendered, and thus give the jury no opportunity of being " triers of the facts of the case." Under the circumstances, the fact that the opinion of Judge McKenna was not submitted nor read to the jury is not a fact to excite astonishment, nor is it a fact which tends to prove that the opinion was not admitted in evidence at all.

Neither do we admit to be correct the statement of counsel, that, if that opinion was not in evidence then there was no evidence whatever of the issue upon which the verdict was rendered. The plaintiff's own testimony, which is not brought out in the Bill of Exceptions and is not before this Court, may have contained any amount of just such evidence.

Further on page 7 counsel states that the question was asked of us, " Was the opinion of Judge McKenna put in evidence to prove matter of fact or matter of law ?" Counsel say that they were not and are not now able to comprehend the answer made by the defendant's counsel. When the question was asked we answered it, and we here repeat the answer, viz.: " The opinion was put in evidence for the purpose of proving *as a fact* what issues of fact Judge McKenna had decided in the former case. It was not put in

“ evidence to prove any matter of law, but solely  
 “ and only to prove a matter of fact.”

Counsel then refer to Mr. Wheaton’s statement made in the Circuit Court and shown on page 78 of the record as follows:

“ If your Honor accepts the decision of Judge  
 “ McKenna for what he describes in it, I think  
 “ that provides the evidence.” Counsel then  
 charge that Mr. Wheaton at that time thought  
 that Judge McKenna’s opinion “ was not only  
 “ competent but conclusive evidence of the facts  
 “ *therein stated* ; but what his present opinion is  
 “ upon that subject,” counsel confess themselves  
 “ utterly unable to understand.”

We will undertake to enlighten counsel as well  
 at to correct their said statement. On page 76  
 of the record, while the witness Fry was upon  
 the stand, he was asked whether or not the ma-  
 chine, Exhibit G, was the identical machine that  
 was introduced in evidence in the case against  
 him. This question was objected to and finally  
 ruled out. Now, the object of this testimony  
 was not to prove any facts that were contained  
 in the opinion of Judge McKenna. Judge Mc-  
 Kenna’s opinion does not state that the machine,  
 Exhibit G, was the machine that was introduced  
 in evidence in that case. The fact that Exhibit  
 G was the machine that was introduced in evi-

dence in that case was a fact that we were offering to prove by independent testimony.

Before Mr. Miller's objection was ruled upon, Mr. Offield, counsel in the case, urged that it was proper to prove that Exhibit G was the identical machine claimed to be the infringement in the Fry case, to show that the question of infringement was the same in both cases. The Court knew, and counsel upon both sides knew, that there had been no evidence introduced in the trial of the present case of any infringement on the part of The Singer Manufacturing Company other than the manufacture and sale of machines like Exhibit G, which was a standard made under the Diehl patent.

As stated on page 77 by Mr. Wheaton, he thought the defendants were required to make out a full case so as to make up the record and show not only that The Singer Manufacturing Company had made the fight in the Fry case, but that the same question was litigated and determined by the judgment in that case which they were litigating in the present case. Of course the opinion of Judge McKenna did not and could not show what they were litigating in the present case. We were offering to show that the question to be decided here was exactly the same question which Judge McKenna had adjudicated. This was not by any means offer-

ing to prove any facts which were stated in the opinion of Judge McKenna, since that opinion did not and could not undertake to say anything about what questions were litigated in the latter case. It was not offering to prove the truth of any facts which were stated in Judge McKenna's opinion. We were offering to prove what facts Judge McKenna had adjudicated and we were *not offering to prove the facts stated in his opinion* upon which that adjudication was based. The statement in counsel's brief therefore that Mr. Wheaton thought that Judge McKenna's opinion was competent and conclusive evidence of the *facts therein stated* is entirely erroneous, and unauthorized.

As shown on page 78 of the transcript, the judge thought that the asking of that question was going into the evidence, stating that he had looked over the decision given by Judge McKenna on the same patents, the Diehl patents and others were referred to.

Mr. Offield then remarked that the descriptive language would identify that machine. It was here that Mr. Wheaton remarked that "If your Honor accepts the decision of Judge McKenna for what *he describes in it*, I think that provides the evidence."

This statement refers to what was *described* in Judge McKenna's opinion. To ascertain what

was described in Judge McKenna's opinion to which this remark was applicable, we refer to 68 Fed. Rep., pages 209 and 210, where such descriptive matter is shown. It is as follows:

“ The definition of the witnesses makes the  
 “ bearing consist of two parts, one movable and  
 “ one immovable; the definition of the books  
 “ makes it consist of either part,—either the mov-  
 “ able or immovable part; the patentee uses it for  
 “ the immovable part. The holes in the cross  
 “ brace are to be the bearings for the trunnions  
 “ of the treadle. The corresponding bearing  
 “ in the defendant's machine is not in the treadle.  
 “ In this particular the devices are different,—  
 “ the bearings are not in the same place. In  
 “ plaintiff's device it happens that both bearings  
 “ are in the cross brace. In defendant's device,  
 “ however, even if we consider the support as  
 “ part of the bearings, as contended for by plain-  
 “ tiff, only one bearing is in the cross brace. But  
 “ in the definition of a bearing we observe that  
 “ the support is not a part of it; a bearing being  
 “ ‘ the portion of the support on which the gud-  
 “ ‘ geon rests and rotates.’ Again, the treadle of  
 “ the patentee is provided with trunnions with  
 “ knife edges; the treadle of the defendant is  
 “ without trunnions and without knife edges.  
 “ This makes another difference. It is familiar  
 “ law that all the elements of a combination must  
 “ be used to make infringement, no matter how

“ immaterial any one may be. Is a treadle with a  
 “ trunnion the same thing as a treadle without a  
 “ trunnion? If not, the omission of the trunnion  
 “ is the omission of the element. But, passing  
 “ this, is a treadle with a trunnion with knife edges  
 “ having bearings in holes in the cross brace sub-  
 “ stantial to the plaintiff’s purpose? It seems to  
 “ me to be. It was urged as the value of the  
 “ plaintiff’s device by Mr. Munn in his letter of  
 “ October 25th; *supra*, and the language of the  
 “ claim cannot be escaped.”

This descriptive matter compares the mechanism of the defendant with the plaintiff’s patent, and it in effect holds and decides and *adjudicates*, that, in order that a machine may infringe the plaintiff’s patent, such machine must contain a cross brace in which there are holes that shall be the bearings for the trunnions of the treadle; that the treadle must be provided with trunnions with knife edges; that a treadle which has no trunnion is not the same thing as a treadle which is provided with trunnions. In short, that in a standard containing a cross brace in which the treadle is secured in position without the use of trunnions with knife bearings which rest in holes that are in the cross brace, there can be no infringement.

Now, taking the judgment roll in the Fry case and applying to it this matter of comparative de-

scription, which was contained in Judge McKenna's opinion, and it seems plain to us that it was perfectly proper for the Circuit Court to direct a verdict in favor of the defendant upon the ground that there was no infringement, especially if the Court accepted said comparative description made by Judge McKenna as a test, and an adjudication which supplied a test, of what a defendant's machine must contain in order to be an infringement of the plaintiff's patent. The Circuit Court of course knew, and this Court will presume that the Circuit Court knew, that the only machines that were ever made, used or sold by The Singer Manufacturing Company, that were asserted to be any infringement of the patent, did not contain a treadle that was supplied with any trunnions, or that were supplied with knife edge bearings or that oscillated in holes that were in the cross brace, and which served as bearings. We repeat the burden of showing error is upon the plaintiff in error. All presumptions are in favor of the regularity of the decision of the Circuit Court. This Court would presume, if it was necessary so to do, that the only machine made by the defendant that was asserted to be an infringement of the plaintiff's patent would be the standard shown on page 204 of 68 Fed. Rep. In that standard, there is a treadle, but that treadle is not supplied with

trunnions, neither does it have or oscillate on any knife edge bearings.

The remark, therefore, made by Mr. Wheaton, shown on page 78 of the transcript, to the effect that if the Court accepted the decision of Judge McKenna for what he described in it that that provided evidence which showed that in the Fry case there was an adjudication between the parties which adjudged that such machines as The Singer Manufacturing Company made and sold were not any infringement of the plaintiff's patent.

We respectfully submit that the opinion of Judge McKenna was relevant and proper testimony to be used for the purpose of showing the particular issue of fact which he had adjudicated in Fry's favor, and the plaintiff in error has no proper ground of complaint growing out of the introduction of evidence in said opinion.

**Plaintiff has no Cause of Complaint upon the ground that fuller proof was not introduced showing the specific issue of fact that was introduced by Judge McKenna in the former case.**

Here we remind the Court and counsel that the burden of showing error is upon the plaintiff in error. He has not seen fit to put into his bill



of exceptions any of the testimony which was before the Circuit Court showing what particular machines were made and sold by the defendant and which he claimed to be an infringement of his patent. The presumptions, therefore, as to what such evidence was, or might have been, should all go to sustain the decision of the Circuit Court. Under this familiar rule the Court will presume that all facts were proved upon the side of the plaintiff which might have been proved in order to sustain the decision of the Circuit Court.

The Circuit Judge stated (transcript, p. 78) that he had looked over the decision given by Judge McKenna and the same patents that were introduced in the present case were referred to in the decision. The judge remarked that he had already made up his mind that that case involved the same matter, and that he had made up his mind that the two cases were the same. This Court will, upon such statement, presume that the evidence taken by the plaintiff in the present case in the Circuit Court was just such evidence as would sustain the ruling of the Court. That testimony was that the machine made under the Diehl patent was the machine which the plaintiff claimed was an infringement of the Cramer patent, and there was no other proof tending to show that the plaintiff had made or sold any other machines

which were claimed or asserted to be, or which were in fact, any infringement of the plaintiff's patent. When the bill of exceptions was made up by plaintiff the trial had been concluded and the plaintiff well knew that we had taken the position that no proof had been introduced which tended to prove any acts on the part of The Singer Manufacturing Company that could constitute any infringement of the plaintiff's patent, or which were claimed to constitute any infringement of such patent, other than the making and selling of the standards of the Diehl patent which included the treadles and the treadle mechanism described in the Diehl patent. Plaintiff has not so far claimed in the oral argument or in the brief that there was any act committed by The Singer Manufacturing Company which constituted any infringement of the plaintiff's patent other than the making and selling of said Diehl standards.

How much testimony there may have been given on the plaintiff's side in the trial of the present case which tended to prove that the same issue was tried and adjudged in the former case which was tried in the present case is not before this Court, and all presumption, therefore, with regard to such testimony will be in favor of the correctness of the ruling of the Circuit Court, and therefore in favor of the defendant in error.

If the plaintiff believed that he was entitled to have fuller testimony as to the identity of the particular machine which Judge McKenna had adjudged not to be any infringement of the plaintiff's patent, he should not have prevented the introduction of the proof which we were offering of such exact identity.

In our former brief herein, on pages 27 to 30, we cited ample authorities to show that a party cannot complain that any fact in the case was not sufficiently proved if he himself prevented the introduction of the evidence which would have proved such fact. We will not go over that ground again here, and merely refer the Court to our said first brief. In making the objection to the admission in evidence of Exhibit G, which we were offering, counsel stated that it was unfair to introduce one piece of evidence from a record in that shape, and carried the idea in his objections that it was necessary for the defendant to prove all the testimony was taken before Judge McKenna instead of proving the issue which Judge McKenna had decided. Of course, this idea was all wrong, as we have already shown.

Neither the counsel nor the Court had the right to assume that the defendant would not have added any testimony that might be needed in order to show the identity of Exhibit G as the

machine which had been adjudged not to be any infringement. As was said by the Supreme Court of California in *Tyler vs. Green*, 28 Cal. 406, on page 409.

“ It is now contended, however, by respondent  
 “ that the evidence was inadmissible because the  
 “ offer did not embrace every fact necessary to  
 “ establish the difference. It was relevant as far  
 “ as it went. The defendant may not have been  
 “ able to prove all the facts by the witnesses then  
 “ under examination. It may be that he intended  
 “ to prove other facts by other witnesses, who  
 “ did not know the facts now offered. It does  
 “ not appear that he was called upon to state  
 “ whether he intended to follow the testimony  
 “ offered by other testimony or not. As this  
 “ essential evidence was excluded, it would have  
 “ been useless to offer testimony as to the other  
 “ facts necessary to sustain this defense, because  
 “ without the testimony offered and excluded he  
 “ must necessarily have failed on that defense. It  
 “ does not appear that the evidence was excluded,  
 “ because the defendant did not propose to prove  
 “ the other facts essential to his defense. If this  
 “ was the point of objection it should have been  
 “ so stated.” The Supreme Court held the ex-  
 clusion of the testimony to be error and reversed  
 the judgment accordingly.

This authority is exactly in point. The idea that a person could offer all of his evidence upon any issue at once, as suggested by counsel, is extremely absurd, as it is usually a physical impossibility so to do. It cannot all be called for in a single question. The plaintiff's counsel has never yet, to our knowledge, ever accomplished such an impossible feat. He has always found it necessary to prove his facts a portion at a time. Such, of course, is the usual and, in fact, universal method of introducing testimony.

On page 18 of plaintiff's said reply brief, it is stated that Mr. Miller's objection was "that the defendant could not be permitted to offer a part or a single piece of his testimony without offering the whole. In other words, that he must stand upon the case as made at the time by the admission of Judge McKenna's opinion, or that he must proceed to offer testimony as to all the matters in evidence on the trial of the former action."

Since, as we have shown, that it would have been entirely improper to offer testimony as to all the matters in evidence on the trial of the former action, the basis of Mr. Miller's objection has no foundation on which to rest. Without any good or legal reason he kept relevant testimony for proving the identity out of the case, and under the authorities which

we cited in our former brief he cannot now complain, or have the judgment reversed, because the fact of said identity was not more fully proved,

On pages 18, 19, etc., of said reply brief, counsel take the position that there can be but *one* judgment entered in an action at law, no matter how numerous the parties to the action may be, or the varieties of the issue joined.

This is but another one of the rank absurdities with which the plaintiff's arguments are alive. In the plaintiff's said former case a judgment was entered in favor of The Singer Manufacturing Company on the 9th day of December, 1893 (record, p. 60). Another judgment was entered in favor of Fry on the 12th day of April, 1895 (record p. 70.) Now, here were two different judgments entered in the same case and at two different dates. No amount of sophistry can convert those *two* judgments into a *single* judgment. It is an every-day proceeding, were several parties are sued, to render one judgment in favor of part of the defendants and another judgment against others of the defendants. Different judgments in favor of different parties in the same case are very common, and are absolutely necessary to the administration of justice. This entering of different judgments in the same case is so common and so necessary that it is a wonder to us that any counsel

would undertake to convince any court to the contrary. As authority to sustain their position, counsel cite *Paige vs. Roeding*, 96 Cal., 388, and *Colton vs. Schwartz*, 99 Cal., 278.

In neither of those cases was there one judgment given for a part of the defendants and another judgment given against another part of the defendants. In each of the cases there appears to have been a trial and a judgment, and afterwards a *later judgment* entered. The appeal was taken from the last judgment and the respondents brought into the Supreme Court proof of the entry of the earlier judgment. There seems to be no showing as to how the two earlier judgments were gotten rid of or whether they were gotten rid of at all. The Supreme Court simply decided that the last judgment was the only real judgment in the case, and that the presumption was that the first judgments were properly set aside before the last judgments were entered.

Beginning on page 18 of said reply brief, counsel complain that they have not been favored with any reply to their argument that a judgment which is in terms without prejudice to the commencement of a new action by Cramer against The Singer Manufacturing Company upon the same cause of action, cannot by any legal possibility be a bar.

This, of course, refers to the judgment in favor of The Singer Manufacturing Company by which it was dismissed from the suit, and which judgment is shown on page 60 of the transcript. We do not claim that that judgment is a bar, nor have we attempted to use it as a bar to prevent the bringing of the present action. There was consequently no argument made by counsel to show that said judgment was not a bar which required any answer. All that it was necessary to say upon this subject was said by us on pages 1 and 2 of our former brief. The judgment which we claim to be a bar is the judgment that was entered at the close of the trial in the case of *Cramer vs. Fry*, which judgment was entered more than a year and four months later, on the 12th day of April, 1895, and is shown on pages 69 and 70 of the record.

We wish to say a word further here as to plaintiff's claim that the defense of the Fry suit was not made openly by The Singer Manufacturing Company. This claim of counsel is not justified by the testimony. When the former case was brought, The Singer Manufacturing Company employed counsel to defend it. A demurrer to the complaint was filed by such counsel, which resulted in the release of The Singer Manufacturing Company from the suit. The same counsel, however, that were originally employed by:



The Singer Manufacturing Company continued to defend the case. This defense was made openly and there was no secrecy about it. Fry being but the agent of The Singer Manufacturing Company, it was perfectly natural that the company should defend the case against him, since it was much more of their business than his, which was the subject of litigation, and all parties would naturally understand that the principal was the one who was defending its own business in defending the agent who was sued for carrying on that principal's business. Besides this, depositions were taken in the East on behalf of Fry, and models were furnished in connection with those depositions that Fry had nothing to do with personally. They were all furnished and paid for by The Singer Manufacturing Company. These depositions were taken and models furnished by The Singer Manufacturing Company in the East, where The Singer Manufacturing Company was doing its business, and 3000 miles away from where Fry was occupied. Of course, counsel for Cramer must have understood that The Singer Manufacturing Company was making the defense. There is not a word of testimony tending to show that The Singer Manufacturing Company in making the defense acted secretly or that the knowledge that they were making the defense was kept away from Cramer's counsel. The law certainly never required that a formal notice

should be served upon counsel on the other side that the principal was defending its agent when that agent was attacked for doing the business of his principal. We have not found any cases in which parties were held protected or estopped when they have defended suits, brought against other parties, in which they were interested which required that the defense should be made any more openly than it was done by The Singer Manufacturing Company in the Fry case. There is not a word of testimony tending to show that the defense of Fry by The Singer Manufacturing Company was not openly made.

We submit that the plaintiff has failed in showing any error or that he is entitled to a reversal of the judgment entered against him by the Circuit Court.

Respectfully submitted,

CHAS. K. OFFIELD,

M. A. WHEATON,

I. M. KALLCOH,

Counsel for Defendant in Error.